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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,334	01/03/2000	MAKOTO SAITO	990696A	7676

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ARMSTRONG, WESTERMAN & HATTORI, LLP  
1725 K STREET, NW.  
SUITE 1000  
WASHINGTON, DC 20006

EXAMINER

HAYES, JOHN W

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/476,334

Applicant(s)

SAITO, MAKOTO

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 71-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 71-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10,16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. Applicant has amended claims 71, 72 and 79 in the response filed 31 May 2002. Thus, claims 71-80 are the only claims remaining in the application and are again presented for examination.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 31 May 2002 has been entered.

### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 11 October 2001 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,069,952 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Arguments***

4. Applicant's arguments with respect to claim 71 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

5. The indicated allowability of claims 72-80 is withdrawn in view of the newly discovered reference(s) to McCarty, U.S. Patent No. 5,666,411. Rejections based on the newly cited reference(s) follow.

***Drawings***

6. The corrected or substitute drawings were received on 31 May 2002. These drawings are approved by the examiner.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 71-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choudhury et al, U.S. Patent No. 5,509,074 in view of Butter et al, U.S. Patent No. 5,381,480 and McCarty, U.S. Patent No. 5,666,411.

As per claims 71-80, Choudhury et al disclose a method of protecting electronically published materials using cryptographic protocols and teaches a method of encrypting unencrypted data using a first secret key (Col. 2, lines 59-61; Col. 4, lines 1-26), supplying the encrypted data to a primary user and decrypting the encrypted data using the first secret key (Col. 2, lines 60-64; Col. 4, lines 1-26), displaying the decrypted data (Col. 2, lines 60-64; Col. 4, lines 1-26). Choudhury et al, however, fail to specifically disclose re-encrypting the decrypted data using a second secret-key and handling storing, copying and transferring the re-encrypted data and not the decrypted data. Butter et al disclose a system for translating encrypted data and further disclose encrypting unencrypted data using a first secret key (Col. 1, lines 10-13 and 47-53; Col. 2, lines 27-31; Col. 3, lines 1-8; Col. 4, lines 10-15), decrypting the data using the first secret key (Col. 1, lines 15-20 and 59-64; Col. 2, lines 7-10 and 30-37; Col. 4, lines 19-23) and re-encrypting the decrypted data using a second secret key and transferring the re-encrypted data and not the decrypted data (Col. 1, lines 19-27; Col. 2, lines 37-53; Col. 3, lines 4-8; Col. 4, lines 27-34). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify

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the method of Choudhury et al et al and include the capability to re-encrypt the decrypted data with a second secret-key and then transfer the re-encrypted data as taught by Butter et al. Butter et al provides motivation by indicating that in some cases, data must be transmitted from a second site to a third site which does not have the same secret key, but a different secret key and that it is sometimes necessary to translate the data using a second secret key that the third site has access to. Thus, information could be encrypted by a first site using a first secret key, decrypted by a second site using the first secret key and further re-encrypted by the second site using the a second secret-key used by the third site.

McCarty discloses a system for computer software protection and teach wherein each workstation is assigned its own cipher key. McCarty further discloses that a workstation is enabled through the use of a copyright control program stored in a ROM (Figure 9-11; Col. 3, lines 1-5; Col. 7, lines 40-45; Col. 9, lines 17-25; Col. 10, lines 20-25; Col. 11, lines 27-35; Col. 12 line 60-Col. 13 line 4) to decipher a protected program under a first cipher and further re-encipher a program using a second cipher and storing within a crypto microprocessor chip without revealing plain text information in a computer's main memory (Col. 5, lines 5-24). McCarty further discloses functions of retrieving, modifying and transferring a register contents back into memory wherein the data block is deciphered under one cipher key and then enciphered under a second cipher key (Col. 6, lines 5-20; Col. 12, lines 25-40). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Choudhury et al and include handling storing, copying and transferring operations on the copyrighted data using the re-encrypted data and not the decrypted data as taught by McCarty. McCarty provides motivation by indicating that this method would prevent a computer program from being executed on computer systems other than those authorized or licensed for the program (Col. 4, lines 30-45) and wherein the protected program is rendered tamperproof (Col. 5, lines 35-40).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982);

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*In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 71-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,128,952.

As per Claims 71-72, Claim 1 of U.S. Patent No. 6,128,605 recites all the limitations of these claims. Claim 1 of U.S. Patent No. 6,128,605 differs since it is an apparatus claim rather than a method claim and further recites additional claim limitations including the elements that make up the system. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No. 6,128,605 by removing certain limitations directed to the elements that make up an apparatus resulting in a method claim such as that of claims 71-72 since both claims actually perform the same function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

### ***Conclusion***

11. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Klonowski discloses a method and apparatus for encrypted communication in data networks and teaches encrypting messages from an originating node to a destination node using one key and further wherein the destination node decrypts the message and then re-encrypts the message with a different key

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- Hamilton et al disclose a method and apparatus for controlling access to digital signals and teach encrypting signals over a first communication path using a first encryption scheme and further decrypting the signals and transmitting the signals over a second communication path using a second encryption scheme.
- Grundy discloses a method and system for decentralized manufacture of copy-controlled software
- Halter et al disclose a method and system for securely distributing a plurality of software files from a distributor to a user
- Nagahama discloses the use of encryption techniques for licensing to use software products that are sold on a piece by piece basis
- Newell discloses a system for preventing unauthorized copying of recorded information
- Matyas et al [EP 0191162 A2] disclose a method of software protection wherein encryption keys are used so that software can be run only on designated computers or by users possessing a designated smart card.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

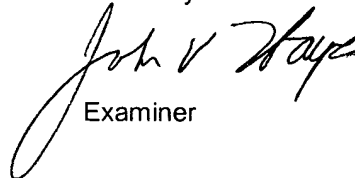
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-5531 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-7687 (for formal communications intended for entry including After-Final communications).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

John Hayes

A handwritten signature in black ink, appearing to read "John V. Hayes", written in a cursive style.

Examiner

19 July 2002